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REMARKS

Applicants appreciate the Final Office Action of November 8, 2005. In particular, Applicants appreciate the Examiner's withdrawal of the Section 101 and 112 rejections. Applicants are in the process of obtaining a certified copy of the Japanese Application and a translation thereof and will submit these documents upon receipt. Applicants respectfully request withdrawal of the claim objections for at least the reasons discussed herein. Applicants have amended the title as set out above and, therefore, respectfully request withdrawal of the objection thereto. Finally, Applicants submit that the pending claims are patentable over the cited references for at least the reasons discussed herein and in Applicants' previously filed Amendment of September 28, 2005 (hereinafter "September 28 Amendment"), filed responsive to the Office Action of June 28, 2005 (hereinafter "the previous Office Action").

Priority

The Final Office Action states that a certified priority document JP-2001-287883 has not been filed. See Final Office, Page 2. Applicants are in the process of obtaining a certified copy of the priority document and a translation thereof, which will be filed in due course.

The Claim Objections

Claims 1 -16 stand objected to as being "[m]erely configured to perform a plurality of calculations/actions but do not actually perform the calculations/actions, as cited in the Office Action dated June 28, 2005." See Final Office Action, page 9. Applicants respectfully submit that this is just a reassertion of the Section 101 rejection that has been withdrawn as a "claim objection." In particular, the Final Office Action just restates the 101 rejection in the previous Office Action as a claim objection without citing any support for the objections. Applicants respectfully submit that for at least the reasons stated in Applicants' September 28 Amendment Claims 1-16 recite statutory subject matter and there is no basis for claim objections thereto. Applicants respectfully submit that there is nothing in the patent law that makes it improper to claim "determining" without "performing" the calculations. Thus, Applicants have not amended the claims as suggested in the Final Office Action. If the claim objections are maintained,

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Applicants respectfully request that the next Action provide support for the claim objections. However, as Applicants respectfully submit that the Final Office Action improperly reads limitations into the patent law, no support can be provided. Accordingly, Applicants respectfully request withdrawal of the objections with respect to Claims 1-16.

The Title

The Final Office Action objects to the title as not being descriptive. *See* Final Office Action, page 9. Applicants have amended the title as set out above and, therefore, request that the objections thereto be withdrawn.

The Section 103 Rejection

Claims 1-16 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over United States Patent No. 5,237,498 to Tenma *et al.* (hereinafter "Tenma") in view of United States Publication No. 2002/0169657 to Singh *et al.* (hereinafter "Singh") and in further view of *Uncovering the Multiple Impact of Retail Promotion on Apparel Store Performance* by Lam (hereinafter "Lam"). *See* Final Office Action, page 10. As the rejections in the Final Office Action appear to be identical to the rejections in the previous Office Action, Applicants respectfully submit that the pending claims are patentable for at least the reasons discussed in Applicants' September 28 Amendment. In the interest of brevity, Applicants will not repeat those arguments herein, but the relevant portions of Applicants' September 28 Amendment are incorporated herein by reference as if set forth in their entirety. Accordingly, Applicants will limit the present response to the "Response to Arguments" section of the Final Office Action. *See* Final Office Action, pages 3-8.

Once again in the Response to Arguments section of the Final Office Action, the specific recitations of the pending claims are not discussed. *See* Final Office Action, pages 3-6. In contrast, the teachings of Tenma, Singh and Lam are discussed without reference to the recitations of the pending claims. For example, Claim 1 recites:

A computer implemented commodity sales number forecasting system for calculating a forecast sales number of a commodity at each shop for the commodity sold in a group of shops within a predetermined district, the computer implemented system comprising:

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a computer implemented district sales number forecasting section configured to calculate the forecast sales number of a commodity within said predetermined district for each unit advertising district residing within said predetermined district performing sales promotion activity at the same time by use of a predetermined advertising medium; and
a computer implemented shop sales number forecasting section configured to calculate the forecast sales number at each shop by distributing the forecast sales number of said commodity in said unit advertising district to each shop within said unit advertising district.

These recitations are not specifically addressed in the Final Office Action. General assertions pointing out what the references discuss does not satisfy the burden of obviousness. In particular, to establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. If each of the recitations is not addressed, the Final Office Action has not shown that the references disclose or suggest "all of the recitations of the claims." Thus, a *prima facie* case of obviousness has not been made for at least these reasons and the reasons discussed in Applicants' September 28 Amendment.

Furthermore, responsive to Applicants' arguments that there is no motivation to combine the cited references as suggested in the previous and Final Office Actions, the Final Office Action states:

In this case, each of the references, Tenma et al., Singh et al. and Lam, share a common field of endeavor namely the management of business process related to the sale/distribution of commodities (products/services) and, therefore, would have been known to those skilled in the art at the time of the invention.

See Final Office Action, page 6. Applicants respectfully submit that the Final Office Action cites Federal Circuit cases from 1988 and 1992 and ignores more recent cases, for example, *In re Sang Su Lee* of 2002. As stated therein:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only

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assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The fact that the references "share a common field of endeavor" cannot satisfy the Office's burden as any two teachings found in the same field of endeavor would render the combination of the two teachings obvious. As stated by the Federal Circuit, more than using Applicants' disclosure as a road map to finding the individual teachings in other references is required. There must be some teaching in the art or the reference that would motivate one of skill in the art to combine the references, *i.e.* without using Applicants' disclosure. The Final Office Action does not point to this motivational teaching. Accordingly, there is no motivation to combine the cited references as suggested in the Final Office Action for at least the reasons discussed herein and in Applicants' September 28 Amendment.

Responsive to Applicants' request for support for the assertions in the Office Action by citation to specific portions of a reference that addresses the specific recitations of the claims, the Final Office Action states that Applicants' Amendment of September 28 is deficient and, therefore, "the Official Notice Statement(s) are taken to be admitted as prior art." *See* Final Office Action, page 8. In particular, the Final Office Action states that Applicants' Amendment of September 28 fails to "specifically point out the supposed errors in the Office Action." *See* Final Office Action, page 8. However, Applicants specifically stated in Applicants' September 28 Amendment that "Applicants request that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Office Action appears to be so vague **that Applicants cannot properly address the combination of the "Official Notice" with the cited references.**" *See* Applicants' September 28 Amendment, page 12. As stated in the M.P.E.P.:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be

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well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

See § M.P.E.P. 2144.03 (emphasis added). Thus, Applicants request for support was valid and the Final Office Action fails to provide such support. Instead, the Final Office Action creates a circular argument. In particular, Applicants requested support for the "Official Notice" and

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stated that the rejections could not properly address the combination of the "Official Notice" with the cited references. Instead of supplying the requested support, the Final Office Action asserts that Applicants response is deficient for not adequately addressing the rejections, which Applicants stated could not be properly addressed, and then states that the inadequate response allows the "Official Notice" to be treated at "prior art." See Final Office Action, page 8. Applicants respectfully submit that additional information, previously requested by Applicants', is needed before a proper response can be made. Thus, treating the "Official Notice" statements as prior art because Applicants' failed to properly address such statements is clearly improper. Applicants' once again request that the Examiner support such assertions with citations to a reference or references as the Official Notice taken in the Final Office Action appears to be so vague that Applicants cannot properly address the combination of the "Official Notice" with the cited references.

CONCLUSION

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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